

29. (New) A cap assembly as set forth in claim 27 wherein a top opening of said straw is disposed co-planar with a top side of said scored finger portion.--

### **REMARKS**

Claims 15, 16, 20 and 21 are pending.

Claims 15, 16, 20 and 21 stand rejected.

Claim 15 has been amended.

Claims 22-29 have been added.

Claims 15, 16, 20 and 21-29 are hereby submitted for consideration.

No new matter has been added.

In the Advisory Action, the Examiner has noted that the Request for Reconsideration filed on October 29, 2002 has not placed claims 15, 16, 20 and 21, rejected under 35 U.S.C. § 112 as containing new subject matter, in better condition for allowance. Specifically, the Examiner cites to the element, "the lower portion is coupled with said side wall" which he contends is not supported by the original specification. The Examiner has not commented on the substantive rejections previously addressed in the Amendment filed on April 30, 2002, in view of the new matter rejection.

Applicant respectfully disagrees with the Examiner's contentions and submits the following remarks in response.

The present invention as claimed in claim 15 is directed to a cap assembly comprised of a container having a plurality of sides and an opening disposed on a top portion of the container.

The opening is disposed at the top of a first one of the plurality of side walls, where the opening is covered by a cap positionable in an opened and closed position. An extendable straw is provided having upper and lower portions. The lower portion extends downwardly against the first side wall, and the upper portion is coupled with an inner side of the cap so that when the cap is in an opened position, the straw is available at the opening for use.

The present invention further claims in claim 22 where the configuration between the upper and lower portions of the straw are such that the pleats are required to allow and unimpeded flow of liquid that passes through said straw.

The present invention further claims in claims 26 where the lower portion is disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall.

The present invention further claims, in claims 16, 24 and 28, that the straw further comprises pleats, disposed between the upper portion of the straw located on the cap and the second lower portion disposed along the first side wall, so that the straw can bend over a base of the scored finger portion.

The present invention further claims in claims 20, 23 and 27 that the cap is a scored finger portion and in claims 21, 25 and 29 it is further claimed that a top opening of the straw is disposed co-planar with a top side of the scored finger portion.

Applicant respectfully submits that all of the elements in the claims as pending, do not constitute new matter.

The relevant portions of the application that support the elements of the claims is found in Figs. 9a and 9b as well as lines 19-23 of page 10 of the specification.

Regarding claim 15, and the lower portion of the straw extending downwardly along the first side wall of the container, there is adequate support in the specification as filed. It is noted

that the drawings in Figs. 9a and 9b clearly illustrate this arrangement. The Court of Appeals for the Federal Circuit has recognized that, “drawings alone may provide a ‘written description’ of an invention as required by §112.” See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ 2d 1111, 1117 (Fed. Cir. 1991); See also *In re Heinle*, 145 USPQ 131 (CCPA 1965) (Where the court stated that it is proper to include matter that is clearly and conclusively disclosed by the drawings. Were the drawings appear to conform to the one-fourth circumference limitation, it is possible to amend the application to include the one-fourth limitation without violating the rule against “new matter”. Both Figs. 9a and 9b illustrate the lower portion of the straw extending downwardly along the side of the carton.

In addition, as described in the specification on page 11 and as shown in Fig. 10c, a pouch is, “sealed to the inside of container 70” and, “a ripple 92 in pouch 66 forms a straw that can be accessed through scored finger 60.” It is evident that this straw is attached to the side wall by virtue of it being formed from a pouch that is sealed to the side wall. In Fig. 10c the straw is illustrated as extending downwardly along the side wall, parallel to the plane of and the edges of the side wall. As such, it is consistent throughout the specification and figures 9a, 9b and 10c and in the accompanying specification to support the claims of the present application.

Claim 22, where the configuration between the upper and lower portions of the straw are such that the pleats are required to allow and unimpeded flow of liquid that passes through said straw, is supported in the specification as filed. For example, lines 22 and 23 on page 10 of the specification read, “Straw 62 has pleats 64 that allow it to bend without impeding the flow of liquid.”

Claim 26, where the lower portion of the straw is disposed along the first side wall, parallel to both the edges of and the plane of the first sidewall, is supported in the specification

as filed. For Example, as illustrated in both Figs. 9a and 9b, the straw 62 is clearly shown extending downwardly along the first side wall, parallel to both the plane of the side wall and the side edges of the first side wall where it connects to the other side walls. The geometry of the drawing indicates parallel alignment of plane of the wall, the edges of the wall and straw.

Claims 16, 24 and 28, where the pleated separation between the upper and lower portions of the straw is clearly supported in the application as filed. Figs. 9a and 9b both show the pleated intersection between the upper and lower portions of the straw. Element 64 specifically identifies the pleats. Lines 22 and 23 of page 10 of the specification reads, "Straw 60 has pleats 64 that allow it to bend without impeding the flow of liquid."

Claims 20, 23 and 27 where the cap is claimed as scored finger portion is clearly supported in the application as filed. Figs 9a and 9b both show the scored finger portion cap. In fact, element 60 shown in both figures, specifically identifies the scored finger portion. Lines 21 and 22 of page 10 of the specification reads, "Instead, carton 70 has a scored finger 60 that can be pulled open to expose straw 62 that is attached to the underside of finger 60."

Claims 21, 25 and 29 where the top of the straw is claimed to be coplanar with the top side of the scored finger portion, is clearly supported in the application as filed. Fig 9b shows the top of straw 62 to be co-planar with the top side of the scored finger portion 60.

As such, in view of the above remarks, Applicant submits that the subject matter of claims 15, 16, 20 and 21-29, do not constitute new matter. Applicant respectfully requests that the rejection of these claims under 35 U.S.C. § 112 be withdrawn, and that the substantive comments entered in response to the Examiner's 35 U.S.C. § 102 rejection from the October 31, 2001 amendment be addressed on their merits.

In view of the aforementioned amendment and remarks, it is respectfully submitted that

all claims currently pending in the above identified application are now in condition for allowance, the earliest possible notice of which is earnestly solicited. If in the Examiner's opinion the prosecution of the present application would be advanced by a telephone interview, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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